

Application file

~~COPY FOR JUDGE~~

Filed on behalf of: Cedars-Sinai Medical Center
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Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)

SRL, K.K.
(09/101,132),
Junior Party,

v.

CEDARS-SINAI MEDICAL CENTER
(08/981,998),
Senior Party.

Patent Interference No. 105,170

CEDARS MISCELLANEOUS MOTION 1
(for identification of government support)

Relief Requested

Senior Party Cedars-Sinai Medical Center ("Cedars") seeks to amend its specification at page 1, following the title of the application, to add the following statement:

This invention was made with Government support under contract NIH R01 NS33123-01A2 awarded by the National Institutes of Health. The Government has certain rights in the invention.

Material Facts in Support of Motion

1. 35 U.S.C. § 202(c)(6) describes the requirements of Government funding as including:

(6) An obligation on the part of the contractor, in the event a United States patent application is filed by or on its behalf or by any assignee of the contractor, to include within the specification of such application and any patent issuing thereon, a statement specifying that the invention was made with Government support and that the Government has certain rights in the invention.

2. 37 C.F.R. § 401.14(f)(4) reads as follows:

(4) The *contractor* agrees to include, within the specification of any United States patent application and any patent issuing thereon covering a subject invention, the following statement, "This invention was made with government support under (identify the *contract*) awarded by (identify the Federal agency). The government has certain rights in the invention."

3. The invention of the Cedars application involved in this Interference, S.N. 08/981,998, was made with Government support under a National Institutes of Health contract grant NIH R01 NS33123-01A2.

4. The applicability of the requirements of 35 U.S.C. § 202 and 37 C.F.R. § 401 was discovered after this Interference was declared on December 11, 2003 and lead counsel for Cedars was selected.

5. Paper No. 22 in this Interference, an Order of APJ Richard Torczon faxed on January 12, 2004 ordered:

that Cedars identify the government entity or entities the support
and the interests that the government has in Cedars' invention.

6. 35 U.S.C. § 202 et seq. and 37 C.F.R. § 401 et seq. describe the interests of the Government to an invention where, as here, it was made with Government grant support.

Reasons Why Relief Should Be Granted

Entry of the amendment to the Cedars application sought by this motion would be in compliance with the Bayh-Dole Act as effectuated by 37 C.F.R. §. 401.14(f)(4) and 35 U.S.C. § 202(c)(6). Further, Cedars has been ordered to provide this information to the Board. And it is submitted that entry of this amendment will provide this information to the public, should the Cedars application ultimately issue as a patent.

37 C.F.R. 1.637(b) Compliance

On January 27, 2004, I left a voice mail with Gerald M. Murphy, Jr., Esq., lead counsel for Junior Party SRL, explaining my intention to file this motion. Mr. Murphy responded by voice mail indicating that SRL would not oppose this motion.

Respectfully submitted,

JONES DAY

Date: January 30, 2004

By Coe A. Bloomberg, Reg. No. 26605
Coe A. Bloomberg
Attorney for Senior Party
Cedars-Sinai Medical Center

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on January 30, 2004, the original and one copy of the foregoing **CEDARS MISCELLANEOUS MOTION 1 (for identification of government support)** is being deposited with the United States Postal Service to be sent by Express Mail in an envelope with sufficient postage addressed to:

Mail Stop Interference
Board of Patent Appeals and Interference
United States Patent and Trademark Office
Alexandria, VA 22313-1450
(703) 308-9797

It is further hereby certified that on January 30, 2004, a copy of the foregoing named document was served on attorneys of record for Junior Party SRL, K.K., by depositing with the United States Postal Service to be sent by Express Mail in an envelope with sufficient postage addressed to:

Gerald M. Murphy, Jr., Esq.
BIRCH STEWART KOLASCH & BIRCH
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Falls Church, VA 22042



Fay Lum-Lee